

No. 11854.

IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

SCHICK SERVICE, INC., and SCHICK, INC.,

Appellants,

vs.

RALPH E. JONES,

Appellee,

and

RALPH E. JONES,

Appellant,

vs.

SCHICK SERVICE, INC., and SCHICK, INC.,

Appellees.

OPENING BRIEF FOR DEFENDANTS- APPELLANTS.

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OPENING BRIEF FOR DEFENDANTS- APPELLANTS.

This is an appeal from an Interlocutory Judgment entered by the District Court of the United States for the Southern District of California, Central Division, holding that claims 22, 23, 31 and 32 of United States Letters Patent No. 2,228,768, granted January 14, 1941 to plaintiff Ralph E. Jones on a Hair Clipping and Shaving Device, are valid and infringed, granting an injunction prohibiting further infringement of these claims, and ordering an accounting for damages.

JURISDICTION.

No question of jurisdiction or pleading is raised by the appeal herein. The Complaint alleges [para. III, R. 8], and the Answer does not deny, that the suit arises under the patent laws of the United States of which the District Courts of the United States have exclusive original jurisdiction. *Judicial Code* § 48.

The appealed Interlocutory Judgment was filed and entered December 31, 1947 [R. 65]; defendants' Notice of Appeal was filed January 12, 1948 [R. 78] (within thirty days thereafter). *Judicial Code* § 129.

STATEMENT OF THE CASE.

The Issues.

On July 6, 1945, plaintiff Ralph E. Jones filed his Complaint against the defendants Schick Service, Inc., and Schick, Inc. [R. 2]. On October 22, 1945, Schick Service, Inc., and Schick, Inc., answered said Complaint [R. 4]. On February 18, 1946, the plaintiff filed his Combined Original and Supplemental Complaints for Infringement of Letters Patent No. 2,228,768, alleging therein the grant of said Letters Patent and the ownership of said patent by plaintiff and the infringement thereof by the defendants; and, as a second cause of action, alleging an oral contract purporting to grant a license from the plaintiff to defendant Schick, Inc., and demanding performance of said oral contract [R. 8]. On February 28, 1946, the defendants filed an Answer to the Combined Original and Supplemental Complaints [R. 12] denying that defendants had infringed United States Letters Patent No. 2,228,768 [para. II, R. 13], and alleging that said Letters Patent and all the claims were invalid and void for the following reasons:

(a) The invention or inventions purported to be patented had been described in printed publications prior to the supposed invention or discovery by the plaintiff [para. VI, R. 14];

(b) That the plaintiff was not the original and first inventor of any material or substantial part of the thing claimed in said patent [para. VII, R. 14];

(c) That the invention or inventions purported to be patented thereby did not constitute patentable novelty or invention within the meaning of the patent laws, in view of the prior state of the art, and in

view of what was common knowledge on the part of those skilled in the art, prior to the date of the alleged invention or inventions of the plaintiff [para. VIII, R. 15];

and denying that the defendant Schick, Inc., had ever entered into any contract with the plaintiff [para. IV, R. 16], and alleging that any claim asserted under the alleged oral contract was barred by the Statute of Limitations of the State of California [para. VII-X, incl., R. 18], and alleging that the alleged oral contract was not by its terms to be performed within one year from the making thereof, that said supposed contract was never in writing subscribed by the defendant Schick, Inc., or by its agents, and that there was not any note or memorandum thereof subscribed by defendant Schick, Inc., or by its agents [para. XI, R. 19]; and was therefore barred by the Statute of Frauds of the State of California (California Civil Code § 1624; California Code of Civil Procedure § 1973).

The Answer [para. I, R. 13] also denied that the defendant Schick, Inc., has any regular and established place of business in the Southern District of California or [para. II, R. 13] has committed any act of infringement in the Southern District of California. This challenge to the court's venue as to defendant Schick, Inc., was determined adversely to the defendant Schick, Inc. [Finding of Fact 4, R. 44-47]. Defendant Schick, Inc., is making no point of this question of venue on this appeal.

The case was tried below upon both the first and second causes of action. The District Court found that claims 1, 11, 17, 18, 19, 20, 24, 25, 26, 27, 28, 29 and 30 were invalid in law [para. 2, R. 62]; that claims 22, 23, 31 and 32 were valid [para. 1, R. 62] and had been infringed by

defendants [para. 4, 5, R. 62-63]; and dismissed the second cause of action [para. 12, R. 65]. Defendants have appealed from the judgment holding claims 22, 23, 31 and 32 valid and infringed [R. 78]. Plaintiff has appealed from the judgment holding claims 1, 11, 26, 27, 28, 29 and 30* to be invalid and from the judgment dismissing his second cause of action [R. 86]. This brief is directed solely to defendants' appeal from the judgment with respect to the validity and infringement of claims 22, 23, 31 and 32. Defendants' position on plaintiff's appeal will be set forth in the brief filed on behalf of defendants in reply to such brief as plaintiff may file on his appeal. In view of the cross-appeals and the various briefs that will be submitted by the parties thereto, we are identifying the parties in this brief as they were in the District Court, to wit: as plaintiff and defendants.

The Patent in Suit

The subject matter of the patent in suit is expressly limited to the making of certain alleged improvements in the well-known Schick type** of electric shavers [R. 425, col. 1, ll. 1-4]. These alleged improvements were urged by plaintiff in the court below to be brought about by adding to the Schick razor so-called guards or flaps (No. 20 in the patent drawings) which are hinged to the razor handle. According to the patent in suit, two objections to

*On March 30, 1948, plaintiff filed in the United States Patent Office a disclaimer of claims 17, 18, 19, 20, 24 and 25 (608 O.G. 831).

**The original Schick electric razor was considered by this Court in *Motoshaver, Inc. v. Schick Dry Shaver*, 112 F.2d 701, and in *Davis v. Schick Dry Shaver*, 112 F.2d 706.

the original Schick razor are obviated by these guards or flaps. The first of these objections is stated in the patent as follows:

“Devices of this kind as placed upon the market are open to the objection that there are two relatively sharp corners on each side of the shaving head and two relatively sharp corners at the extremities of the shaving head. These corners, when the instrument is pressed against the face or other part, are annoying and uncomfortable, particularly inasmuch as the device must be pressed firmly against the face in order that it shall cut properly and make a ‘clean shave.’” [R. 425, col. 1, ll. 13-23.]

To meet this objection the patent proposes:

“Each of these guards at its outer end is rounded, as at 24, so that its outer face extends longitudinally of the guard and inward towards and merges into the flat upper face of the channeled head 12.” [R. 426, col. 1, ll. 41-45.]

The second objection is set forth in the patent as follows:

“In devices of this kind, the channel-shaped head is held in place against accidental detachment by means of a set screw passing through a channel-shaped recess in the handle, which recess contains the head. Due to the very rapid vibrations given to the cutter within the head, this set screw often becomes loosened, and in that case, the head is liable to fall out, carrying with it the cutter, and the cutter and head may drop against some very hard object as, for instance, a washstand, floor or the like, and damage the cutter head or the cutter itself, thus rendering the instrument impossible for use until these parts have

been replaced or duplicated at considerable expense.”
[R. 425, col. 1, ll. 23-38.]

This objection, the patent explains, is overcome by extending the guards “across both ends of the channel-shaped head, which will hold the channel-shaped head in position without the necessity of using a set screw” [R. 425, col. 1, ll. 57-59].

Each of the guards or flaps has an opening 35 so that a “blast of air will blow the hairs which may have collected in channel 17 out through the opposite guard” [R. 426, col. 2, ll. 68-70]. From this it is apparent that the guards or flaps 20 of the patent in suit were not designed to function or serve as collectors for the beard cuttings. This is further confirmed by the shape of the guards or flaps which are relatively flat and provide no reservoir or storage space in which the beard cuttings could be stored, even were they not to blow out through the holes 35 [R. 360].

The Accused Devices.

The devices which the District Court has held infringe claims 22, 23, 31 and 32 are the Schick electric dry shavers [Physical Exhibits 2, 3, 4, 5 herein; R. 62, 63]. These have been held to infringe because of the mounting thereon of the hair receptacles described and covered by Patent No. 2,275,022 issued to the defendant Schick, Inc. [R. 464-6; Dfts. Exh. L-3]. Contrary to the guards or flaps of the patent in suit, these receptacles are imperforate and of a shape enabling them to catch and store the hair or beard clippings. These receptacles or clipping collectors

are called "whisk-its" by the defendants. They are not provided for the purpose of holding the channeled head to the handle nor to prevent scratching or cutting [R. 360]. Very similar receptacles or trash collectors have been used in other arts. Compare the receptacle or retainer *L* in Patent No. 765,954 dated July 26, 1904, for a Punch [R. 550-552; Dfts. Exh. L-19]. Such a punch provided with a retainer like the retainer *L* for collecting chips or clippings is in evidence as Defendants' Exhibit N [R. 332]. The wide sale of this punch in 1923 and in subsequent years is stipulated [R. 330-31] and is illustrated in the catalogue of the McGill Metal Products Co. of Chicago, Illinois [Dfts. Exh. M].

Rounding.

As we shall see, it is difficult, if not impossible, to ascertain the basis upon which the court below found that claims 22, 23, 31 and 32 can be sustained and held infringed by defendants' whisk-its. Such a holding could be supported only by finding something patentably new in the patent in suit which is employed in the accused devices. Since the defendants' whisk-it serves the purpose of a reservoir or hair collector and plaintiff's patent does not, and since plaintiff's guards or flaps are utilized to hold the head in position without the necessity of using a set screw and defendants' whisk-its are not, the question remains: What is it that plaintiff asserts is patentably new and which may be found both in the patent in suit and in defendants' whisk-its?

This question is left unanswered by the decision and findings of the court below unless it can be answered by

inference from Finding of Fact 17 [R. 53] where the court below said:

“By the invention of the patent in suit, the skin of the user is protected against the relatively sharp edges and corners on the ends of the shaving head, and this provides substantial shaving comfort to the user which in turn permits a faster shave than would otherwise be possible, which is highly desirable.”

In stating that the invention of the patent in suit provides shaving comfort, the court in this finding has stated the result or function of the purported invention but has not identified the means of accomplishing the same, and therefore has not identified the invention. This, however, is supplied in the testimony of the plaintiff who plainly states that any added comfort “depends entirely on eliminating the sharp corners, or sharp edges at the razor head” [R. 181]. The way the patent teaches to protect against such sharp corners or edges is to round them off [R. 425, col. 1, ll. 39-48]. While there is some confusion in the wording of the patent as between rounding off the corners and edges of the cutting head itself as compared with rounding off the edges and corners of the guards or flaps 20, the plaintiff in his testimony at the trial conceded that infringement of the patent in suit depends entirely upon the latter. On this point the following question was put to plaintiff’s attorney by the court below:

“The Court: Does the plaintiff contend that the use of any sort of an end guard, whether it has a sharp edge or not, is an infringement of the patent in suit?

“Mr. Harris: Certainly not, your Honor. The end guard must be rounded so as to provide shaving comfort, which we are talking about.

“* * * if they put an end guard on the shaver, in which you left sharp corners on the cutting head projecting so as to interfere with shaving comfort, then I would not contend that was an infringement of the patent. This is a patent covering end guards rounded so as to add shaving comfort to the user.” [R. 188-9.]

The District Court did not, however, regard the rounding off of the sharp corners or edges of either the razor head or guards as sufficient to sustain the patent in suit. Of the claims sustained by the District Court, claims 22 and 23 refer to “rounded guard elements,” and claim 32 refers to “rounded” end flaps, none of the claims defining the extent or degree of such rounding. Claim 31, sustained by the District Court, makes no reference to rounding. On the other hand, all of the claims held invalid by the District Court (claims 1, 11, 17, 18, 19, 20, 24, 25, 26, 27, 28, 29 and 30) not only include the rounding of both the cutter head and the guards but define such rounding by calling for the rounding surfaces of the guards merging into the surfaces of the head. While plaintiff has filed a cross-appeal from this ruling as to some of the claims held invalid by the District Court, he has filed a disclaimer (*supra*) as to claims 17, 18, 19, 20, 24 and 25. Each of the latter claims calls for rounding.

Certainly the District Court cannot be criticized for failing to predicate its decision sustaining claims 22, 23, 31 and 32 upon the rounding off of corners and sharp edges. By no stretch of the imagination could the use of

so well-known an expedient be deemed to constitute a patentable invention. Everyone knows that the way to protect against a sharp corner or edge is to round off the corner or edge. This expedient is commonplace everywhere in mechanics. Everyone knows of it. It was well known in the shaver art. In the shaving art it is very old to provide a razor or other device with a rounded guard to prevent sharp edges. An example of this is shown in the patent to Peterson No. 1,744,280 [Exh. L-4, R. 470]. This patent describes a guard which is used with the ordinary Gillette safety razor. Such a razor has square ends like the squared ends complained of in the patent in suit [col. 1, ll. 13-23; R. 425]. The patent in suit teaches that a rounded device placed at the end of the channeled head of the razor would give a smoother, more satisfactory shave [R. 377]. That is exactly the teaching of the Peterson patent [Exh. L-4]. In the Peterson patent is described a body portion 1 which has shields 4. The body portion corresponds to the channeled head of the Jones patent, and a view of the drawings shows that the shields 4 are curved and rounded into the channel portion 1 to make a smooth uninterrupted curve so that the edges or corners of the razor blade 11 cannot cut or scratch. The patent states [col. 2, ll. 74-79, R. 472]:

“The fact of the matter is, it may be used with greater comfort upon smooth surfaces of the face and body than can the ordinary razor and my improved razor may, therefore, be said to be adapted to shave any part of the human body without fear of injury thereto.”

Patent No. 1,801,889 to Ventimiglia (Exh. L-5, R. 474] describes a dry shaver whereby all the sharp edges

or corners are rounded off to prevent scratching and cutting. The outer portion of this device A is closed at its end 5 by a rounded shield, as shown in the drawing [R. 377]. Patent No. 1,516,635 to Friedman [Exh. L-6, R. 478] shows an electric shaver having a rounded gauge plate 1 which would come in contact with the skin, rounded at 4 to make the device slide over the skin more readily [R. 377]. The patent to Szabo, No. 1,175,023 [Exh. L-7, R. 484], shows a hair cutting device that has a guard member shown in cross section in Figure 4 and the ends are covered with round corners which round into the line of the comb to prevent damage or injury to the skin [R. 378]. Patent No. 2,014,882 to Dean [Exh. L-8, R. 490] shows an attachment adapted to be put on a conventional hair clipper which forms rounded beads 18 at the corners of the shaving head to prevent cutting or scratching [R. 378].

None of this art was cited by the Examiner and there is therefore no presumption that the claims of the patent in suit are valid over such art. Comparing the claims, for example claim 22, with the exhibits just set forth, we have claim 22 calling for "an open-ended channeled head, and rounded guard elements hinged to the device at the opposite ends of said head." The Peterson patent [Exh. L-4, R. 470] describes a "channeled head," that is, the usual square-ended Gillette safety razor to which are added "rounded guard elements."

At the trial plaintiff asserted on the witness stand that in 1935, prior to designing the device of the patent in suit, he had a Schick shaver the edges of which were "very sharp" [R. 115]. This shaver was not produced at the

trial. Plaintiff was confronted with Exhibit B and acknowledged that it was "unmistakably an earlier model than the one that I had" [R. 192]. Plaintiff acknowledged that the beads on the head of this Exhibit B "are somewhat beveled and somewhat rounded" [R. 193]. At the trial defendants produced the witnesses Bert C. Quasnovsky [R. 278-332] and Norman Gray [R. 332-395] from the plant of defendant Schick, Inc., at Stamford, Connecticut, both of whom testified to the fact that the edges and corners of the Schick electric shaver have always been, from the earliest days of that shaver, rounded off to avoid cutting or scratching of the skin and to give shaving comfort. The witness Quasnovsky produced an original drawing [Exh. G, R. 453] from the engineering files of the defendant Schick, Inc., dated January 4, 1932, showing on its face where and how the rounding was to take place. Quasnovsky testified that he made this drawing [R. 284-5] and that he initialed and dated the drawing in his own handwriting. Both Quasnovsky [R. 302-3] and Gray [R. 358] testified to the fact that at the factory all Schick shavers have always been inspected in a department maintained for that purpose to see that any edges or corners "are nice and rounded" [R. 302]. The testimony of the witnesses Quasnovsky and Gray was not contradicted at the trial. Indeed, it was fully corroborated by plaintiff who himself admitted that the sharp edges of the Schick razors prior to his alleged invention were rounded at least "to some extent" [R. 195]. Nevertheless, during the argument the District Judge announced, "I am not going to believe the defendants' witnesses in this case" [R. 406] and in the findings of fact stated, "the testimony and demeanor of both failed to carry any conviction as to the

dates of manufacture or sale of Exhibits B, F, H and I, or any of them" [Finding of Fact 15, R. 52]. This arbitrary rejection of the uncontradicted evidence of defendants' witnesses we hereafter specify as error.

Hinging.

The only remaining clue to the basis for the District Court's decision in this case lies in contrasting the claims held valid by the District Court with those held invalid. The difference should reveal whatever it was the District Court deemed to be a patentable invention that was infringed by the accused structures. If this contrast be made it leads to a truly remarkable answer to the question. Evidently the District Court sustained claims 22, 23, 31 and 32 of the patent in suit because a hinge is employed in the patent in suit to secure the end guards to the shaver handle. An examination of the wording of claims 22, 23, 31 and 32 shows that each of these claims called for this hinging. A comparison of all the claims held invalid by the District Court shows that none of such claims refers to such hinging. There is nothing in the decision or the findings of fact or conclusions of law expressly referring to the hinging, but the hinging is the only difference between invalid and valid claims according to the ruling of the District Court. How the court could sustain the patent on this point is quite beyond our understanding in view of the fact that the court, during the trial, obtained a concession from plaintiff's counsel that there was nothing patentable about the hinging:

"The Court: Do you contend that the hinging itself is a patentable feature?

Mr. Harris: Oh, hinging by itself, there is nothing patentable about that. That is an old element.” [R. 404.]

Plaintiff’s counsel could not have answered otherwise. Hinging is one of the oldest and commonest manners of attaching one element to another. It is an ordinary mechanical expedient known to all. The receptacle *L* shown in patent 765,954 [Exh. L-19] for collecting the punchings or clippings, as demonstrated in defendants’ Physical Exhibit N, is hinged to the punch handle.

No wonder there is uncertainty in the District Judge’s decision as to whether claims 22, 23, 31 and 32 embody any invention. The court admitted its doubt in its oral opinion:

“It is a debatable question whether they embody invention but, in combination, I find that with respect to claims 22, 23, 31, and 32, the improvements which are described are not only novel and useful but do embody invention.” [R. 412.]

The District Court has left entirely to surmise what these “improvements” may be. Evidently they were not the rounding of the corners or edges of the guards, and plaintiff has conceded there is no invention in the hinging. The wording of the patent itself demonstrates that there is no patentable combination of these two admittedly unpatentable features. The statement of the inventor in the patent to this effect is as follows:

“While I have described both guards 20 as being hinged or pivoted by means of the pivot pins 23, I do not wish to be limited to this as it is obvious that one of these guards, or both of them, might be permanently fixed in closed position and rigidly attached to the handle.” [col. 1, ll. 24-29, R. 427.]

SPECIFICATION OF ERRORS.

1. The court below erred in failing to hold that claims 22, 23, 31 and 32 in suit are void for lack of invention.

2. The court below erred in holding that claims 22, 23, 31 and 32 are infringed by defendants' shavers of types exemplified by physical Exhibits 2, 3, 4 and 5.

3. The court below erred in making its Finding of Fact No. 15 [R. 51-52] rejecting the testimony of the witnesses Quasnovsky and Gray as to the manufacture and sale of Exhibits B, F, H and I.

4. The court below erred in making its Finding of Fact No. 14 [R. 50-51] that the prior art patents and the prior art paper punch [Exh. M] are irrelevant and immaterial.

5. The court below erred in making its Finding of Fact No. 17 [R. 53] that the invention of the patent in suit has provided a substantial contribution in the art of dry shavers.

6. The court below erred in making its Finding of Fact No. 18 [R. 53-55] in finding that the file wrapper record for the patent in suit does not so limit or restrict the scope of claims 22, 23, 31 and 32 as to avoid infringement by defendants' shavers, exemplified by physical Exhibits 2, 3, 4 and 5, and that plaintiff made no admissions in such proceedings which would restrict or limit the scope or interpretation of such claims so far as such shavers are concerned.

7. The court below erred in failing to find that, in view of the fact that no device built according to the drawings and specification of the patent in suit has ever been made or commercially used, the patent is to be strictly construed and limited to the device there shown and described, and is therefore not infringed by defendants' shavers exemplified by physical Exhibits 2, 3, 4 and 5.

8. The court below erred in making its Finding of Fact No. 26 [R. 59] that infringement by defendants of the patent in suit has been conscious, deliberate, wilful and wanton, particularly in view of the fact that the manufacture and sale of the accused shavers was begun by the defendants prior to the issue of the patent in suit without knowledge of plaintiff's alleged invention, and that prior to the judgment of the court below, none of the claims of such patent had been judicially sustained and even now most of the claims, as found by the court below, are invalid.

9. The court below erred in granting an injunction [R. 63] restraining defendants from infringing claims 22, 23, 31 and 32 of the patent in suit.

10. The court below erred in ordering the case referred to a special master [R. 64] to determine damages for said infringement.

11. The court below erred in not adjudging that plaintiff's complaint for infringement of the Letters Patent in suit be dismissed and that defendants recover their costs including attorneys' fees.

SUMMARY OF ARGUMENT.

Point 1. There is no invention in rounding off the edges of a device with a guard.

Point 2. There is no invention in hinging a guard.

Point 3. Providing a dry shaver with rounded guards hinged on its handle is not a patentable combination.

Point 4. The Jones patent does not point out and distinctly claim the alleged invention.

Point 5. It is the duty of the court in a patent case to protect the public from invalid patents.

Point 6. Defendants' accused shavers [Exhibits 2, 3, 4 and 5] should not be held to infringe claims 22, 23, 31 and 32.

Point 7. The court below erred in making its Finding of Fact 15 rejecting the testimony of the witnesses Quasnovsky and Gray as to the manufacture and sale of Exhibits B, F, H and I.

Point 8. The District Court erred in making Finding of Fact 26 that the infringement of defendants was "conscious, deliberate, wilful and wanton."

ARGUMENT.

POINT I.

There Is No Invention in Rounding Off the Edges of a Device With a Guard.

There is no invention in rounding off the edges of a device with a guard. In the shaving art it is very old to provide a razor or other device with a rounded guard to prevent sharp edges. Only the skill of a mere novice, not an expert, would be necessary to understand that a shaver would cut and scratch if it were not rounded.

“‘A mere difference or change in the mechanical construction in the size or form of the thing used, in order to obviate known defects existing in the previous devices, although such changes are highly advantageous, and far better and more efficacious and convenient, does not make the improved device patentable. In order to be patentable, it must embody some new idea or principle not before known. It must, as before stated, be a discovery, as distinguished from mere mechanical skill or knowledge. (Citing cases.)’” *Keszthelyi v. Doheny Stone Drill Co. et al.*, 59 F.2d 3, 8 (C.C.A. 9).

See also:

R. G. LeTourneau v. Gar Wood Industries, 151 F.2d 432, 434 (C.C.A. 9);

Emmett v. Metals Processing Corporation, 118 F.2d 796, 799 (C.C.A. 9);

Grayson Heat Control, Limited v. Los Angeles Gas Appliance Co., Inc., 134 F.2d 478, 481 (C.C.A. 9).

The proof is conclusive that it is very old to provide a razor or other device with rounded guards to prevent sharp edges. This proof is directly contradictory to the District Court's Finding of Fact 14 [R. 50-51]. The prior art patents [Exhibits L-4, L-5, L-6, L-7 and L-8, R. 470, 474, 478, 484 and 490] all are for shaving instruments; they all teach that a smoother, more comfortable shave can be secured by rounding and providing guards on the sharp corners of the shaving instruments.

The patent to Peterson [Exhibit L-4] describes a guard rounding off the ends of the square-shaped common Gillette razor. This patent specifically provides that with this guard and rounded surface greater comfort can be secured [R. 472, ll. 74-79; R. 377].

The patents to Ventimiglia [Exhibit L-5] and to Friedman [Exhibit L-6] are for dry shavers and distinctly call for rounding off the edges to prevent injury [R. 377].

The patents to Szabo [Exhibit L-7] and to Dean [Exhibit L-8] are hair clippers and describe guard members to prevent scratching and cutting and provide "more comfort in its use" [R. 378].

The Supreme Court in *Charles Guidet v. City of Brooklyn*, 105 U.S. 550, held that to make a device "rougher" would not constitute invention. The Court therein held that, where it was obvious that a rougher device would be superior, it would be no invention to make the same rough. The corollary of this case is

the present one. It is obvious to anyone that a sharp edge in a shaving device would be dangerous and a round one would be safe. Therefore, it would be obvious to any mechanic to make rounded ends upon the shaving head.

The District Court in its Finding of Fact 14 [R. 50-51] held that none of the prior art exhibits “. . . describe or disclose or suggest a dry shaver wherein the principle, mode of operation, or results attained are equivalent to those of patent No. 2,228,768.” The error in this Finding is patent. Exhibits L-4, L-5, L-6, L-7 and L-8 all describe shaving devices; all describe methods and devices to round the corners of the shaving head. Even after making Finding of Fact 14 the District Court apparently saw the error contained in said Finding. As he did not hold that rounding a guard was invention, any possible interpretation of the District Court's decision is that it is not novel and not invention to provide rounded guard members. The Court held an entire set of claims of the patent invalid as lacking in invention.

“The remaining claims in suit do not, in my opinion, embody invention and are invalid because of indefiniteness.” [R. 412, Find. of Fact 20, R. 55; Conclusion of Law 3, R. 59.]

These claims 1, 11, 17, 18, 19, 20, 24, 25, 26, 27, 28, 29 and 30 all describe a rounded guard member. If there were any invention in a rounded guard member all of these claims would be valid. The District Court held only claims 22, 23, 31 and 32 as valid and disclosing invention.

POINT II.

There Is No Invention in Hinging a Guard.

There is no invention in hinging a guard to a device. The plaintiff's attorney admitted that there was nothing patentable about hinging the guards to the handle of the Jones patent [R. 404].

"The Court: Do you contend that the hinging itself is a patentable feature?

"Mr. Harris: Oh, hinging by itself, there is nothing patentable about that. That is an old element."

Hinging is one of the oldest manners of attaching one device to another. However, the District Court seemed to believe that there was invention in attaching the guard by means of a hinge. The Court declared all of the claims that call for the rounded guard members to be *hinged* to be valid and all of the claims that did not include the hinge to be invalid for lack of invention and indefiniteness [R. 412].

There can be no other interpretation of the District Judge's decision than that a hinged guard was the invention of the patent in suit. This decision was made even after the admission of plaintiff's counsel that this did not constitute invention.

A case almost identical to the present case is *Monckmeier v. Erie Mfg. Co.*, 98 F.2d 369 (C.C.A. 7). In that

case the patent described a bumper or radiator guard which was pivotally hinged on a bumper of an automobile so that it would protect the radiator grill. The hinge was for a similar purpose to that of the patent in suit, to swing the device out of the way of a door on the automobile. When in use the bumper guard obstructed and kept the door from opening just as the guard elements of the patent in suit, when in use, prevent the removal of the channeled head. By hinging or pivoting the bumper guard and the guard element of the patent in suit, both of them could be swung out of the way so that the door of the car or the channeled head could be opened or removed. The Circuit Court there held that so hinging was not invention.

Another example of hinging a guard is the patent to Bernard [Exhibit L-19, R. 550]. This patent describes a paper punch which is similar to the Physical Exhibit N. The paper punches of both Exhibits N and L-19 have rounded guard members [*L* in Exhibit L-19]. They are hinged so that they can be opened. In both cases the guard is rounded off to provide a smooth surface to prevent it catching upon the sheets of paper. The guard receives the paper punchings and is opened by swinging on the pivots to empty the punchings [R. 373-375]. The purpose of this guard is the same as the "Whisk-its" used on all four Schick shavers which the District Court held to infringe the patent in suit [Exhibits 2, 3, 4 and 5;

Find. of Fact 18, R. 53-54]. The purpose of these “Whisk-its” is as described by the witness Gray:

“A. They are intended to catch the beard clippings that come from the inner portion of the shearing head.

Q. Are they relied upon, or do they function to prevent the razor from scratching or cutting? If the Whisk-its were not on the razor, I mean by that, will the razor head itself scratch or cut, if those Whisk-its are not present?

A. No, it will not. This shearing head is manufactured to be used on this late model; also on the earlier models that do not have whisk-its.” [R. 360.]

The guard members described in the Jones patent will not function as a receptacle for beard clippings. The opening 35 would allow a substantial quantity of clippings to fall out. There is no reservoir space to receive clippings.

“Q. Would the guard members 20 referred to in that patent and illustrated in the drawings of that patent serve as beard or clipping catchers? A. No; they would not.

Q. Why not? A. Because they have no reservoir capacity and because they have a hole in them.” [R. 360.]

POINT III.

Providing a Dry Shaver With Rounded Guards Hinged on Its Handle Is Not a Patentable Combination.

Providing a dry shaver with rounded guards hinged on its handle is not a patentable combination. As there is no invention in rounding off the edges of a device or in hinging a guard to a device, there can be no invention in the combination of a hinged and rounded guard. The basic error in the District Court's decision is the determination that while rounding and hinging are not patentable when combined these two elements constitute invention [R. 412].

The mere selection of well-known elements and combining them in a device where they have the same mode of operation and same function is not invention.

Mettler v. Peabody Engineering Corporation, 77 F.2d 56 (C.C.A. 9);

Eagle v. P. & C. Hand Forged Tool Co., 74 F.2d 918 (C.C.A. 9);

Toledo Pressed Steel Company v. Standard Parts, Inc., 307 U.S. 350, 83 L.ed. 1334;

Keszthelyi v. Doheny Stone Drill Co., 59 F.2d 3 (C.C.A. 9);

Ray, et al., v. Bunting Iron Works, 4 F.2d 214 (C.C.A. 9);

Magarian v. Detroit Products Co., 128 F.2d 544 (C.C.A. 9).

Claim 22, for example, describes nothing but rounding a guard member and hinging the same. As shown *supra* plaintiff admitted that hinging is old and well-known in

the art and the Court has held that there is nothing new in rounding off a corner. To combine the two is nothing more than the selection of these two elements.

“* * * ‘That the new combination accomplishes a better result does not alone evidence invention. ‘The union of the selected elements may be an improvement upon anything the art contains, but, if, in combining them, no novel idea is developed, there is no patentable invention, however great the improvement may be.’ * * *”

Mettler v. Peabody Engineering Corporation, supra.

POINT IV.

The Jones Patent Does Not Point Out and Distinctly Claim the Alleged Invention.

The Jones patent does not point out and distinctly claim the alleged invention. The patent law provides that an inventor to secure a patent must “* * * particularly point out and distinctly claim” his invention (R.S.U.S. 4888, 35 U.S.C.A. § 33).

The Supreme Court in *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 368, and this Court in *Farmers’ Cooperative Exchange v. Turnbow*, 111 F.2d 728, 732 (C.C.A. 9), have held that this statute is violated when the inventor uses “conveniently functional language at the exact point of novelty.”

In the Jones patent all that is described concerning how to manufacture a guard which will give shaving comfort is the statement that the guard must be round. In three of the four claims held valid by the District Court,

22, 23 and 32, the statement is merely that the guards must be round. There is no description of how round or what part of the guard must be round. In claim 31 the inventor even failed to use the word "round" but just called his end guards "end flaps." The inventor on cross-examination was unable to explain how round the device must be to be covered by the patent.

"Q. That rounding applies to something different than beveling, and indicates some kind of a curvature, as you have used the term, is that so? A. The curvature, however, might be variable.

Q. Depending on what that curvature was, you might or you might not obtain the added comfort, the purpose directed in your patent, is that correct? A. Depending on what it was, yes. I don't know just how to answer that question. If you eliminate the sharp edge, you increase the comfort.

Q. How sharp does the edge have to be to be a sharp edge, as you are using that term, a 90-degree edge? A. It is a sharp edge if it is as sharp as the ends of this Schick shaver are right now, with the whisk-its in the open position, or removed.

Q. You are referring to Exhibit 3? A. Yes.

Q. Do you know whether or not those edges have been rounded off in the manufacture of that exhibit? A. Yes, there is a certain very minute rounding there.

Q. Why do you say it is minute? A. Because it isn't enough to get any comfort." [R. 184-185.]

His interpretation of the word "round" meant to round the guard element until it gave a satisfactory shave.

“Q. So far as improving the comfort in the Schick razor is concerned, by what is shown in your patent in suit, that improvement is accomplished entirely by eliminating the sharp corners or points or sharp edges, is that correct? A. That is correct, provided that we mean by that the substitution of curved surfaces or rounded liberal radius.

Q. The value of that radius is in no case in the specifications of your patent in suit, is it? A. Well, yes.

Q. Will you turn to the specification and point to any place in the wording of the specification which specifies the value of that radius? At any time in this examination, Colonel Jones, that it will take a considerable time to arrive at an answer, because you have to examine the document, or something, and you would rather make that examination during the recess, to save the court's time, you can take the question under advisement, as we say in our calculating machine case. A. I am not sure that I can find an answer to that question immediately. I hardly think it ought to be necessary, because what I refer to is just what you doubtless recall. It says that the guards at this certain point are reasonably thick. That starts a curve more or less at a 90-degree segment of a circle.

Q. You can have just as little rounding on an edge or corner of a guard 20 having a thick end as with a thin end? A. These are rounded the maximum of that thickness.

Q. Does the specification so state? A. The drawings so show.

Q. Does the specification so state? A. Not in those words, no, sir.” [R. 181-182.]

This testimony is very relevant when it is added to the testimony of Jones in regard to his testimony as to Exhibit 3 where he stated that the edges of that razor were rounded at the ends but not sufficient to give shaving comfort:

“Q. You are referring to Exhibit 3? A. Yes.

Q. Do you know whether or not those edges have been rounded off in the manufacture of that exhibit?

A. Yes, there is a certain very minute rounding there.

Q. Why do you say it is minute? A. Because it isn't enough to get any comfort.” [R. 184-185.]

The definition of the word “round” in the Jones patent means that it is “round enough to give shaving comfort.” A statement that a thing is round enough to secure shaving comfort is not a description of the physical shape of the object but is a description of *what the object will do* if it is *round enough*. If it is round enough it will give shaving comfort; if it is not round enough it will not give shaving comfort.

The claims held valid do not describe a device other than with the word “round.” It is admitted by Jones that the earliest Schick razors had rounded ends and edges. There is no definition in the claims to distinguish the word “round” from the “round” ends and edges of the prior Schick shavers [Exhibits B, F, H and I]. The only distinction attempted by the inventor is that one gives comfort and the other does not.

“Q. Does your patent tell you to state how much more to round those surfaces than they had been rounded in the prior Schick devices? A. In no specific manner, I believe. It just teaches the advantage

of having a sufficient—in this effect of having a sufficient radius and rounding to accomplish the comfort.

Q. Do you know why those surfaces were rounded at all in the prior Schick razors? A. Well, of course, if they were sharp you would cut your finger on them and cut your face with them.

Q. Weren't they rounded to add comfort to the razor? A. Certainly, to a certain extent, of course, because otherwise you would really cut your face.

Q. All you proposed in so far as this point was concerned was to round them some more; is that correct? A. Enlarge them and round them some more so far as comfort of these long lateral edges are concerned; that is correct, sir.

Q. Does your patent state how much larger to make them? A. No, sir; not specifically in the specification." [R. 195-196.]

The Jones patent definitely does not distinguish between the earlier Schick razors and the present Schick razors in the matter of how round the surfaces are to be. The only definition of the word "round" is that if made round enough it will give shaving comfort. This is merely a functional statement. The only way of determining whether the device would infringe the patent would be to make a test to see if it were round enough to give shaving comfort or if it would give discomfort. As the comfort necessary to one person varies this would be a variable test and not particularly pointing out and distinctly claiming the invention as required in R.S.U.S. 4888.

General Electric Company v. Wabash Appliance Corporation, supra;

Farmers Cooperative Exchange, Inc., v. Turnbow, et al., supra.

POINT V

It Is the Duty of the Court in a Patent Case to Protect the Public From Invalid Patents.

The public is always a third party to an infringement suit and its rights may not be waived by the conduct of alleged infringers. It is the duty of the Court to consider the validity of a patent before considering the question of infringement.

“* * * It must be as much the duty of the court in a patent case to protect the public against having to pay tribute to a patentee who is not in any true sense an inventor or discoverer, as to protect the patent rights of one who is a real inventor. See *Cuno Engineering Corporation v. Automatic Devices Corporation*, *supra* (page 92 of 314 U.S., 62 S.Ct. 37, 86 L.Ed. 58); *Muncie Gear Works, Inc., v. Outboard, Marine & Mfg. Co.*, 315 U.S. 759, 768, 62 S.Ct. 865, 86 L.Ed. 1171.” *Frank Adam Electric Co. v. Colt's Patent Fire Arms Mfg. Co.*, 148 F.2d 497, 502 (C.C.A. 8).

See also:

Sinclair & Carroll Company v. Interchemical Corporation, 325 U.S. 327, 89 L.Ed. 1644;

Phillips Petroleum Co. v. Shell Development Co., 73 USPQ 28 (D.C.D. Del.).

POINT VI

**Defendants' Accused Shavers [Exhibits 2, 3, 4 and 5]
Should Not Be Held to Infringe Claims 22, 23, 31
and 32.**

Defendants' accused shavers [Exhibits 2, 3, 4 and 5] materially differ in many respects from the "Hair Clipping and Shaving Device" described and claimed in the Jones patent.

In the specification of the patent in suit the shaving head 12 is provided with a lip 25 which is engaged by a lug 27 on the guards 20 to hold the head 12 upon the handle 10 [R. 426, col. 1, ll. 52-66]. The purpose expressed in the patent in attaching the head by means of the guard is to do away with the set screw normally used in electric shavers to prevent the loosening of the set screw and the accidental dropping of the shaving head [R. 425, col. 1, ll. 23-38].

None of the accused Exhibits 2, 3, 4 or 5 has the shaving head held in the handle by the guards. They all use a set screw to hold the head upon the handle. This use is claimed to be objectionable in the patent [R. 425, col. 1, ll. 23-38].

The patent in suit should be given a narrow interpretation to the exact device described; that is, guard elements that hold the head on the handle. Such a device has never been manufactured or sold by the plaintiff and there is no evidence anywhere in the record that any such device has ever been manufactured or sold.

"Q. Col. Jones, before you filed your patent application did you construct or have constructed a

razor embodying the improvements that are referred to in your patent in suit? A. No, sir.

Q. Have you ever? A. I have never." [R. 174.]

It is well settled law that a patent for a device which has never been manufactured and utilized is to be strictly construed. Compare the decision of this Court in *Cocks v. Rip Van Winkle Wall Bed Co.*, 28 F.2d 921, at 922:

"Another reason why the appellants' combination should not receive the construction due to a pioneer invention, but, on the other hand, should be strictly construed, is the fact that although the invention had been patented nearly ten years before the present suit was begun, it had not been utilized or placed upon the market but was still a paper patent. While the validity of a patent is not affected by its nonuser, *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 28 S.Ct. 748, 52 L.Ed. 1122, the nonuser has a bearing on its construction, and the courts are not disposed to give the same any broader scope than it is clearly required to be given, *Westinghouse Elec. & Mfg. Co. v. Toledo, P.C. & L.Ry. Co.* (C.C.A.), 172 F. 371; *Wesel Mfg. Co. v. Printing Mach. Co.* (D.C.), 218 F. 178; *Kestner Evaporator Co. v. American Evaporator Co.* (C.C.), 182 F. 844."

(See also *Henry v. City of Los Angeles*, 255 Fed. 769, at 780 (C.C.A. 9).

In lieu of applying this rule to the admittedly unused patent in suit, the court has applied directly the opposite rule. The District Court has held that the patent in suit "is entitled to be liberally construed and interpreted" [R. 53].

The patentee Jones in his specification dwells at length on the necessity and the advantages of holding the channeled head upon the handle by means of the guard and without the use of set screws [R. 425, p. 1, col. 1, ll. 23-38, ll. 55-59; R. 427, col. 1, ll. 24-39]. If there is any novelty in the Jones patent, the means for holding the channeled head in position is that novelty and as the defendants do not use any such device, they cannot infringe the patent in suit:

“Both the drawings and the specification of the appellee’s device show that both its lower and its upper waffle members are separately pivotally connected with its base or grill member, which three parts the patentee, as has been shown, expressly declares to be the principal parts of his invention. It is plain, therefore, that to eliminate either one of those parts is, as is said for the appellant, to destroy not only the structure but the law of operation of the device of the appellee. That a claim for a combination to be valid must be for an operative combination is clear. (Citing cases.)” *Pacific States Electric Co. v. Wright*, 277 Fed. 756, at 758 (C. C. A. 9).

Another material difference between defendants’ accused devices and the device described in the patent in suit is that the accused devices all have reinforcing members at the ends of the shaving head which rise above the shaving surface of the head and act as guards for that shaving head. The patent in suit does not describe such a reinforcing member [R. 363]. During the prosecution of the application for the patent in suit the patentee, Jones, in

distinguishing his invention from a device having such reinforcing member, said:

“The patent to Aaron does not show an end portion which MERGES into the upper face of the head because this end portion shown in Figure 4 extends upward beyond the face of the head and does not merge thereinto as is clearly shown in Fig. 1 and more clearly shown in Fig. 4.” [Paper No. 10, filed January 26, 1937, Exhibit K.]

The patent to Aaron [Exh. L-11], which was the patent referred to by the patentee, discloses a dry shaver which has a shaving head indicated and called a “cylindrical housing 105.” At the ends of this head (see Figure 4 at the upper left corner) are rounded projections. One of these is disclosed in the drawing at each end of the cutting head. The purpose of these projections is two-fold: (1) to act as a reinforcing bar as found by the court [Finding of Fact 16, R. 52], and (2) to permit rounding of the end of the head. These reinforcing bars were used on substantially all Schick shavers [Exh. 2, 3, 4, 5, B, F, H and I; R. 314-317]. The purpose of these reinforcing bars or elements is explained in the testimony of Gray: “In addition to guarding against damage, the reinforcing element is made thicker so that operations dealing with the rounding of the shearing head can be performed, if this reinforcer were extremely thin, as the shear plate is, it is not strong enough to stand up under the rounding operation.” [R. 356.] These reinforcing elements which constitute rounded guards were in use long before any purported invention by Jones [R. 356].

The claims of the patent in suit must, in view of the representation made to the Patent Office, be limited to a shaver that does not have these reinforcing elements and in which the guard merges into the flat surface of the shaving head and does not rise above the flat surface. Having secured a patent upon this narrow and specific statement after the rejection of broader claims [Paper No. 11, filed January 28, 1937, Exhibit K], the patentee cannot successfully assert that his claims cover what is rejected and cancelled.

Lorraine v. Townsend, 290 Fed. 54 (C.C.A. 9);

Warren Bros. Co. v. Thompson, 293 Fed. 745
(C.C.A. 9);

John I. Paulding, Inc. v. Leviton, 45 F.2d 125,
127 (C.C.A. 2);

*Johnson Furnace & Engineering Co. v. Western
Furnace Co.*, 178 Fed. 819, 824 (C.C.A. 8);

Macbeth v. Gillinder, 54 Fed. 169, 170 (C.C. E.D.
Penn.);

Atkins v. Gordon, 86 F.2d 595, 596 (C.C.A. 7);

Beasley Power Mower Co., Inc. v. Pearce, 38 F.
Supp. 756, 759 (D.C. E.D. Wisc.).

Defendants' accused shavers do not have the guards merging into the flat surface of the head as stated by the patentee, Jones [Paper 10, Exhibit K]. They do extend "upward beyond the face of the head." Where a patent

depends for its novelty over the prior art upon a simple limited feature of construction, to infringe, this feature must be present in the defendant's device.

Pacific States Electric Co. v. Wright, supra;

Standard Mirror Co. v. H. W. Brown, Inc., 113
F.2d 379, 380 (C.C.A. 7).

The devices of the patent in suit were designed to obtain two results: (1) to hold the head upon the handle [R. 425, col 1, ll. 23-37], and (2) to provide shaving comfort [R. 427, col. 1, ll. 3-4]. A material difference between defendants' accused shavers and the patent in suit is that the "whisk-its" upon the accused devices do not accomplish either of these results but have a separate function, *i.e.*, to collect beard clippings [R. 360]. This function is not possible in the devices of the patent in suit. The holes in the guards 20 would permit the beard clippings to fall from them. In fact, during the prosecution of the application leading to the issuance of the patent, the inventor, Jones, attempted to secure an interference with patent No. 2,066,214 to Meyer [Exhibit L-2], owned by defendants and under which defendants manufacture the "whisk-its" [R. 369, 370]. The patent to Meyer describes the purpose of the "whisk-its" of defendants' accused shavers. That purpose is to collect the beard clippings and prevent them from "falling on to the skin or clothing of the one shaving." [R. 461, col. 1, ll. 3-10.] The Patent Office Examiner refused to grant such an interference after Jones had submitted original

claims 44, 45 and 46 directed to flaps closing the end of the head [Paper No. 21, Exhibit K, filed January 18, 1939]. This refusal was on the grounds that the application of Jones did not describe "closure flaps" which close the ends of the channeled head. Jones acquiesced in the final rejection of the claims [Paper No. 23, filed February 11, 1939, Exhibit K] by cancelling the rejected claim 46 and rewriting claims 44 and 45 as claims 31 and 32 of the patent as issued [Paper No. 30, filed April 3, 1939, Exhibit K]. Claims 31 and 32 were rewritten to describe "end flaps" and not to describe closure flaps. The function of "end flaps" is to hold the head on to the handle and to give shaving comfort. The cancellation and rewriting of the claims is an admission that Jones was not the inventor of devices for collecting beard trimmings.

Lorraine v. Townsend, supra;

Warren Bros. Co. v. Thompson, supra;

John I. Paulding, Inc. v. Leviton, supra;

*Johnson Furnace & Engineering Co. v. Western
Furnace Co., supra;*

Macbeth v. Gillinder, supra;

Atkins v. Gordon, supra;

Beasley Power Mower Co., Inc. v. Pearce, supra.

POINT VII.

The Court Below Erred in Making Its Finding of Fact 15 Rejecting the Testimony of the Witnesses Quasnovsky and Gray as to the Manufacture and Sale of Exhibits B, F, H and I.

The Court below erred in making its Finding of Fact 15 rejecting the testimony of the witnesses Quasnovsky and Gray as to the manufacture and sale of Exhibits B, F, H and I. The District Court decided that he did not believe any of the witnesses for the defendants:

“The Court: I am not going to believe the defendants’ witnesses in this case.” [R. 406.]

In Finding of Fact 15 [R. 52] the only reason given for not believing these witnesses is

“* * * I have carefully observed the demeanor of both of these witnesses in open court and specifically find that the testimony and demeanor of both fail to carry any conviction * * *” [R. 52.]

The District Court did not specify in what way the witnesses’ demeanor led him to believe that they were not trustworthy witnesses. The prejudice of the District Court that caused him to make Finding of Fact 15 is shown by the fact that substantially all of the testimony of both Quasnovsky and Gray was corroborated by documentary exhibits such as Exhibit G and physical exhibits such as Exhibits B, F, H and I. The testimony of the witnesses Quasnovsky and Gray as to the date of manu-

facture of Exhibit B was corroborated by the plaintiff who testified that Exhibit B was “unmistakably an earlier model than the one I had” and used prior to the conception of the alleged invention of the patent in suit [R. 114-115, 192-193].

No evidence was introduced by plaintiff contrary to the testimony of Quasnovsky and Gray that all Schick shavers manufactured prior to any conception of the alleged invention had the edges, ends and corners rounded off to provide shaving comfort. There was no attempt by the plaintiff to introduce any of these early Schick razors showing sharp corners and the plaintiff was unable to produce a razor having sharp corners; in fact, he testified that the razor he used prior to his conception of the invention was in his opinion sharp but the corners and edges were rounded off [R. 195].

Finding of Fact 15 should be of no legal significance. It is arbitrary and not in accord with the legal requirements. As said in *Pittsburgh S. S. Co. v. National Labor Relations Board*, 167 F.2d 126, 129, (C.C.A. 6):

“Courts have recognized that it is contrary to human experience that all witnesses on one side of a case are falsifiers while those on the other side are all truthful, and this conclusion must be obvious to anyone with even a minimum experience as a trier of facts.”

POINT VIII.

The District Court Erred in Making Finding of Fact 26 That the Infringement of Defendants Was “Conscious, Deliberate, Wilful and Wanton.”

The District Court has found in Finding of Fact 26 [R. 59] that the defendants have infringed the patent in suit in a conscious, deliberate, wilful and wanton manner. There is no evidence in the record of any character to sustain such a finding nor can any inference be made from any of the evidence that any infringement was conscious, deliberate, wilful and wanton. Such a finding is necessary to enable the Court to assess punitive damages as provided in *R.S.U.S. 4921, 35 U.S.C.A., § 70*.

The courts have uniformly held that conscious, deliberate, wilful and wanton infringement upon which punitive damages can be predicated can only be found when the infringement was made under no claim of right, that is, the infringer did not have a debatable defense either as to infringement or validity. There is no claim in this case that the defense of validity and infringement asserted by the defendants herein was a sham defense. The District Court held a large plurality of the claims of the patent in suit invalid for lack of invention and indefiniteness [R. 55]. The District Court also stated that his decision was very doubtful and that it was a debatable question whether or not claims 22, 23, 31 and 32 were valid [R. 412]. Certainly the defendants in this case have proved, and the District Court has recognized that the defense herein of invalidity and non-infringement were not sham defenses and had substance. Where the District Court finds such facts it is improper to hold

that the infringement of claims that are debatable as to their validity is conscious, deliberate, wilful and wanton.

“To question the validity of a patent does not, of itself, constitute wilful infringement. *General Motors Corporation v. Dailey*, 6 Cir., 93 F.2d 938, 942. If honestly mistaken as to a reasonably debatable question of validity, an infringer should not be made to smart in punitive damages. Compensatory damages constitute adequate remuneration for invasion of a patentee’s property rights, unless the refusal of the infringer to bow to the presumptive validity of an issued patent is consciously wrongful.”

Enterprise Mfg. Co. v. Shakespeare Co., 141 F.2d 916, 920-921 (C.C.A. 6).

See also:

General Motors Corporation v. Dailey, 93 F.2d 938, 942 (C.C.A. 6);

Brown Bag Filling Mach. Co. v. Drohen, 175 Fed. 576 (C.C.A. 2);

Rockwood, et al. v. General Fire Extinguisher Co., et al., 37 F.2d 62, 66 (C.C.A. 2);

Egry Register Co. v. Standard Register Co., 23 F.2d 438, 443 (C.C.A. 6);

Creagmile, et al. v. John Bean Mfg. Co., et al., 32 F. Supp. 646, 648 (D.C.S.D.Cal.).

The actual fact in this case is that there was nothing conscious, deliberate, wilful or wanton in the alleged infringement of the defendants. The defendants were manufacturing and selling the devices herein held to infringe for several years prior to the issuance of the patent in suit and to any actual knowledge of the patent in suit

[Exhibit 8, R. 431 and R. 369-370]. Defendants were manufacturing and selling the devices held to be an infringement under patents owned by the defendants [R. 369, 371]. These patents are the patent to Meyer, No. 2,066,214 [Exhibit L-2, R. 458, 369] and to Thomas No. 2,275,022 [Exhibit L-3, R. 463, 371]. The function of the “whisk-its” on the accused devices is not the function of the guards described in the patent in suit, that is, to add to the comfort and to hold the shaving head on the handle. The “whisk-its” are intended to catch the beard clippings [R. 360]. The patent in suit does not provide a device for catching beard clippings [R. 360].

Conclusion.

We respectfully submit that the District Court has clearly erred in sustaining the validity of claims 22, 23, 31 and 32 of the patent in suit and in holding them infringed by defendants’ shavers like Exhibits 2, 3, 4 and 5. Accordingly, we urge the Interlocutory Judgment below be reversed as to paragraphs 1, 4, 5, 6, 7, 8, 9, 10, 11 and 13 thereof, and that the District Court be directed to dismiss plaintiff’s Complaint with costs to defendants.

Respectfully submitted,

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